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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,026	07/10/2001	Suhayya Abu-Hakima	8303/3	9283
7590	02/24/2005		EXAMINER	
Baniak Pine & Gannon Suite 1200 150 North Wacker Drive Chicago, IL 60606			HANNE, SARA M	
			ART UNIT	PAPER NUMBER
			2179	
DATE MAILED: 02/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/902,026	ABU-HAKIMA ET AL.	
	Examiner	Art Unit	
	Sara M Hanne	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 June 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,4-8 and 11-14 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1, 4-8 and 11-14 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. This office action is responsive to the amendment received 6/18/04. Examiner notes pending claims 1, 4-8 and 11-14 with cancelled claims 2,3, 9 and 10, and currently amended claims 1, 4, 6, 8, 11 and 13.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1, 4-8 and 11-14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the alternative limitations "concepts/themes" and "sub-concepts/sub-themes" throughout the claims is improper and renders the claims indefinite. It is unclear which limitation is meant to define the Claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1, 4-5, 8 and 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Wical, US Patent 6460034.

As in Claims 1 and 8, Wical teaches an electronic document viewer system for presenting on an electronic display a plurality of electronic documents input from a source, said system comprising: a concept recognizer component configured for recognizing concepts/themes and sub-concepts/sub-themes associated with content of documents (Col. 25, lines 7, et seq. and Col. 33, lines 18-25) a prioritization analyzer component configured for ordering the recognized concepts/themes and sub-concepts/sub-themes with the documents associated therewith, according to a user's priorities (Col. 3, lines 12-13, Col 33, lines 50-51, query is input by the user to specify the user's priorities), a viewer component configured for presenting on the display a first hierarchical level of multiple levels of prioritized concept identifiers interlinked according to a hierarchical structure based on ordering (Figure 8c), wherein each concept identifier represents the documents associated therewith and a concept or theme recognized by the concept recognizer and upon selection of a concept identifier by the user, for selectively presenting on the display a second level of the prioritized concept identifiers (Fig. 10a, 10b and corresponding text).

As in Claims 4 and 11, Wical teaches an input document processing component configured for outputting a static document map corresponding to the input electronic documents ("Document theme vector", Ref. 160).

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As in Claims 5 and 12, Wical teaches a highlighter component configured for identifying key content of said input document on the basis of said document map (Col. 32-33).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-7 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wical, US Patent 6460034, and further in view of Hyatt, US Patent 6678602.

In reference to Claims 6 and 13, Wical teaches identification of key content within an input document and creation of a static document map for creating a hierarchical configuration based on user's priorities and identified concepts (see rejections *supra*).

While Wical teaches the viewer system and method for creating the hierarchy, recognizing concepts and themes, creating document maps and identifying key content, Wical fails to show displaying a predetermined amount of key content for a document corresponding to the particulars presented by the viewer component when a cursor operated by a user is positioned in the area of the particulars as recited in the claims. In the same field of the invention, Hyatt teaches a hierarchy configuration method similar to that of Wical. In addition, Hyatt further teaches displaying a predetermined amount of

data for the node with which the cursor position corresponds ("provide a supplementary 'bubble' of information on the display when a mouse cursor is positioned on a node of interest", Column 13, lines 26-28). It would have been obvious to one of ordinary skill in the art, having the teachings of Wical and Hyatt before him at the time the invention was made, to modify the viewer system and method for creating the hierarchy as taught by Wical to include the proximity selection of nodes to display a given amount of key data of Hyatt, in order to obtain a preview for a node document that may be in consideration by the user. One would have been motivated to make such a combination because a method for previewing the information without opening the document would have been obtained so as to determine whether or not the user is interested in the document, as taught by Hyatt.

In reference to Claims 7 and 14, Wical teaches a concept learner component that creates new knowledge pertaining to the user based on data sensed from the system's environment for input to a knowledge base of user data ("the learning processing 165 disambiguates the context of a term by assigning a category for terms and themes previously unclassified", Column 6, lines 52-54).

Response to Arguments

Applicant's arguments filed 6/18/2004 have been fully considered but they are not persuasive.

The stated prior art of Wical reads on the claims as currently stated and as a "document presentation system for a computer display/viewer" as cited on page 7 of the

submitted remarks filed 6/18/2004. Wical teaches receiving documents from a source (See Col. 5, line 35 et seq.).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a set of email documents" and "documents received from an ISP/server or set of websites received from a search engine", Page 7 or remarks) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to the argument that "none of Wical's disclosure has anything to do with a presentation system or means" and Wical does not teach "any means for presenting documents to a user", the examiner disagrees (For example see Col. 25, line 17). Furthermore, the recitation "presentation system or means" need not be given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to the argument that Wical does not teach display of the hierarchy and selectively presenting a second hierarchical level the examiner would like to point out the Claim 1 rejection *supra* and the disclosure describing Figures 10a and 10b.

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In response to the argument that there is no motivation to combine Hyatt with Wical the examiner disagrees. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hyatt teaches a hierarchical display and delivery of documents to a user similar to that of Wical (See figure 4).

The term amended in to the claims, "particulars", does nothing to help distinguish the invention from the prior art. In fact, replacing "leaf node" with "particulars" broadens the claims and does not particularly point out any specific limitation. The amendment further complicates the claims by adding "/themes and sub-concepts/sub-themes". This alternative limitation is confusing, and could be worded in a way to better define the main concepts of the application. Therefore, the claims, as currently presented, do nothing to overcome the previously stated rejections by the prior art of Wical and Wical in combination with Hyatt.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M Hanne whose telephone number is (571) 272-4135. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smh

BA HUYNH
PRIMARY EXAMINER